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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,718	01/23/2004	Bryan Nathan Wilmoth	M005Z/281291	7327
23370	7590	08/26/2005	EXAMINER	
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			KIM, SANG K	
			ART UNIT	PAPER NUMBER
			3654	

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/763,718

Applicant(s)

WILMOTH ET AL.

Examiner

SANG KIM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8-16, 18 and 21 is/are rejected.
- 7) ☒ Claim(s) 4, 6, 7, 17, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/3/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "a system with a first spool, a second spool, a nip between the second spool and the paper web, and a computer controlling the pneumatic system" recited in claims 1, 12-13 and 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 5, 8-15 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6416012 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application and of the patent are drawn to the same invention, but differ only in specificity and obvious wording changes. The invention broadly claimed in this application is obviously encompassed by the claims of the patent.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodriguez, U.S. Patent No. 4659029.

With respect to claims 1, 3, 5, Rodriguez '029 teaches a system for cutting a traveling web from a first spool and onto a second spool by feeding a turn-up tape (24) along a transfer track (28) beneath the paper web (20) and to a position adjacent to the nip (52); and a drive assembly (43, i.e., a hand crank) capable of driving the turn-up tape along the transfer track toward the nip, wherein the drive is capable of being powered by manual power or motor power, see figure 1, and on column 8, lines 59-61.

Applicant is advised that the intended use of the claimed apparatus in claim 1, "for" cutting a traveling web from one spool to next spool by feeding turn-up tape into a nip between the spool winding the web, does not distinguish over the prior art because it relates only to the material wound on to the reel but does not impart or define any particular structural limitations to the claims.

With respect to claim 2, Rodriguez '029 teaches the drive assembly with a drive shaft (108) coupled to a drive wheel (41), the drive assembly with an engaging wheel (55) engaging the turn-up tape between the drive wheel (41), see figure 2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-16, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez, U.S. Patent No. 4659029, in view of Rodriguez, U.S. Patent No. 6305634 B1.

With respect to claims 8-10, 13-14, 16 and 18, Rodriguez '029 teaches a system for cutting a traveling web from a first spool and onto a second spool by feeding a turn-up tape (24) along a transfer track (28) beneath the paper web (20) and to a position adjacent to the nip (52), wherein the transfer track has an U-shaped groove without a flexible seal; and a drive assembly (43, i.e., a hand crank) capable of driving the turn-up tape along the transfer track toward the nip, wherein the drive is capable of being powered by manual power or motor power, see figure 1, and on column 8, lines 59-61.

Rodriguez '634 teaches a transfer track with a V-shaped groove (20) with first and second side walls (no reference number) and a flexible seal (18) for transporting the turn-up tape (21), see figure 1.

Rodriguez '029 discloses the claimed invention except for a V-shaped groove for the transfer track along with a flexible seal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the track with a V-shape groove and a flexible seal to prevent any debris from entering as taught in Rodriguez '634 in latter part of the invention.

Applicant is advised that the intended use of the claimed apparatus in claims 13 and 21, "for" cutting a traveling web from one spool to next spool by feeding turn-up tape into a nip between the spool winding the web, does not distinguish over the prior

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art because it relates only to the material wound on to the reel but does not impart or define any particular structural limitations to the claims.

With respect to claims 11-12, as advanced above, Rodriguez '634 shows air supply system which controls the air pressure, see figure 5.

Rodriguez '029 and '634 disclose the claimed invention except for an automation mode with a computer for the system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus by adding a computer into an automation process since computers are well known and used throughout the industry.

With respect to claim 15, as advanced above, Rodriguez '029 teaches the drive assembly with a drive shaft (108) coupled to a drive wheel (41), the drive assembly with an engaging wheel (55) engaging the turn-up tape between the drive wheel (41), see figure 2.

With respect to claim 21, the method described in these claims would inherently result from the use of invention of Rodriguez '029 and '634 as advanced above.

Rodriguez '634 shows an air supply system which controls the air pressure, see figure 5.

Rodriguez '029 teaches a drive (43) which is manually powered, but it can also be an electric motor, see column 8, lines 59-61.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus by adding a computer into an automation

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process since computers are well known and used throughout the industry and using both drive systems in the apparatus in case one of the drive systems fails.

### ***Allowable Subject Matter***

Claims 4, 6-7, 17 and 19-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SANG KIM whose telephone number is 571-272-6947. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:30 P.M. alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki, can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.



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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SK

8/12/05

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